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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/088,163	06/01/1998	JOHN R. MOSER, JR	960514.ORI	1414

7590 03/27/2002

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EXAMINER

MILLER, EDWARD A

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/088,163	MOSER, JR, JOHN R.
	<b>Examiner</b>	<b>Art Unit</b>
	Edward A. Miller	3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 January 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 39-42,45-52 and 55-69 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 39-42,45-52 and 55-69 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The information disclosure statement filed October 2, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. To the extent that the documents therein were already of record in the "parent" of this CPA application, this represents a duplication of something already in the record and a waste of office, as well as applicants' resources. If the documents are from another source, then it appears that copies are required. For now, the 1449 will be retained in the file without any documents being crossed off, in case applicants perfect the filing as to documents not already of record by filing copies thereof.

3. Claims 39-42, 45-52 and 55-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite. In claim 51, lines 3-5, as an example of all the claims with polymer language, the language is not understandable, or said another way, the metes and bounds of the claims is not clear. In line 5 thereof, "binder polymer" appears excess, or it is not clear how this relates to the preceding language of either line 3 or line 4. Line 3 recites "tetramethylene", while line 4 only recites "hydroxy-terminated adipate prepolymer". In this, the generic name in line 3 is specific, while the precursor language in line 4 is unlimited. This is inconsistent and fails to allow reasonable ascertaining of the metes and bounds of the invention. This may be viewed as a lack of antecedent basis, chemically, or as an affirmative narrow limitation (PTMA, e.g.) being "(improperly)

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further limited" be a broader expression (PA), which is inconsistent. This language must be corrected throughout. In claims 68 and 69, lines 5-6 of each, "said one or more isocyanate-cured ..." lacks antecedent basis. The same lack of antecedent basis problem is found at claim 65, lines 6-7. Further, in various places including specifically claims 65, 68 and 69, the initial recitation is for cured adipates, which includes any type of cure, while later limitations recite being cured by isocyanate. This is unclear as to whether an affirmative limitation is intended for all the cured adipates, or if this permits, e.g., 99% epoxy cured adipates from carboxy terminated polymers added to 1% hydroxy polymer cured with isocyanate. These remain exemplary.

4. Although the claims are examined as to prior art, in some instances, assumptions had to be made to do so. This is for the purpose of advancing the prosecution of this application. It has been held improper, indeed, reversible error, to rely on speculation as to the meaning of indefinite claims, and then reject that speculative meaning on prior art. *In re Steele*, 305 F.2d 858, 134 USPQ 292 [CCPA 1962], *Ex parte Brummer*, 12 USPQ2d 1653 at 1655 [USPTO BOPAI 1989].

5. Claims 39-42, 45-52 and 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradford et al. in view of Chi et al., Willer and Fleming, for reasons et forth in paragraph 2 of Paper No. 6, incorporated herein by reference.

6. Claims 39-42, 45-52 and 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton et al. in view of Hauser et al., Godfrey, Genetti et al., and Kangas.

Sutton et al. teach the basics of polyester polymer binders, e.g., at col. 4, lines 52-75. It would have been obvious to use a similar polyol, as well known in this art, as in the polyester art, col. 4, line 63. Hauser et al. clearly suggests the use of tetramethylene glycol, at col. 2, line 16, and substitution of such would have been obvious to one of ordinary skill in the art. Godfrey is primarily cumulative, but with a specific teaching of curing catalysts when carboxy terminated

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polyesters are used. Genetti et al., col. 5, line 67 through col. 6, line 15, e.g., and Kangas, at col. 4, lines 56-60 and col. 5, lines 1-2, 6, and 13, further show that the polyester itself is well known in the polymer art, e.g. Variation of specific, notoriously well known parameters would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person or ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Applicant's arguments are essentially that the same composition is not taught, which is correct in that the rejection is under section 103 of 35 U.C.S., not section 102. That the polymer ingredients are suggested and closely related, even homologs, as in Hauser et al. above, is overlooked in the arguments. Substitution of such would have been obvious to one of ordinary skill, absent unexpected results. Compare *In re Riden*, 138 USPQ 112, e.g.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
March 25, 2002

  
EDWARD A. MILLER  
PRIMARY EXAMINER